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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,103	01/20/2004	Sylvie Gauthier	6674-0037-1	4659
50811 7590 07/09/2009 O'Shea Getz P.C. 1500 MAIN ST. SUITE 912 SPRINGFIELD, MA 01115				
EXAMINER				
TRAN, THAO T				
ART UNIT		PAPER NUMBER		
1794				
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07/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/762,103

Applicant(s)

GAUTHIER ET AL.

Examiner

Thao T. Tran

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/16/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 22-32 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 22-32 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's Appeal Brief submission after final filed on 9/16/2008 has been entered.
2. Claims 1-7, 22-32, 34-38 are currently pending in this application.
3. The double patenting rejections are sustained. The previous prior art rejections have been withdrawn.
4. In light of the IDS filed on 6/17/2008, a new rejection of the claims is as set forth below.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3-6, and 22-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, and 9 of Copending Application, Serial No. 10/762,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application

contain the subject matter that is narrower in scope than that in the instant claims, rendering them obvious over each other.

Claims 1-2, 4-7, and 9 of the copending application recite all of the limitations in instant claims 1, 3-6, and 22-32. Moreover, claims 1 and 6 of the copending application disclose an underlayer and a backer in addition to the core layer and the first decorative layer. Thus, claims 1 and 6 of the copending application are narrower in scope than the instant claims, rendering them obvious over each other.

7. Claims 1-7, 22-32, 34-38 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,179,538 whether alone, or in view of Lindenfeiser '325 or Albrinck '974, or in view of Hiers et al. (US Pat. 4,132,821). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims is narrower than that of the instant claims, rendering them obvious over each other.

In regards to instant claims 1-6, claims 1-5 of the patent contain all the limitations in the instant claims. However, the patented independent claims 1, 2, and 3 include the flexible backing layer in addition to the leather layer and the decorative layer of instant claim 1. Thus, the scope of the instant claims embraces that of the patented claims, rendering them obvious over each other.

In regards to claims 7 and 22-32, the patented claims do not specify the resin impregnating the cellulose paper or the weight percent of the resin.

Lindenfeiser discloses a laminate comprising a core sheet impregnated with 33-35% melamine-formaldehyde resin (see col. 2, ln. 15-32). Albrinck discloses a laminate having a core sheet impregnated with 25-35% melamine-formaldehyde resin (see col. 4, ln. 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the amounts of melamine-formaldehyde resin in the core sheet, as taught by Lindenfeiser or Albrinck, in the laminate of the patented claims, to impart hardness, abrasion and solvent resistance, thus durability to the layer.

In regards to claims 34-38, the patented claims do not specify the leather including animal hide.

Hiers discloses the use of leather containing animal hides (see col. 1, ln. 6-9).

Therefore, it would have been obvious to one of ordinary skill in the art to have employed leather comprising animal hides as taught by Hiers in the laminate of the patented claims, because leather containing animal hides as well as artificial leather have been conventionally used in the art of decorative articles. Moreover, natural leather is more biodegradable and environmentally friendly.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 1-7, 22-32, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroyoshi (JP 05-237006) or Schmidt-Troschke (DE 4447171) alone or in view of Wilson et al. (US Pat. 2,601,671). The references are cited in the IDS of 6/17/08, 6/28/07, and 1/20/04.

Hiroyoshi and Schmidt-Troschke each disclose a laminate, comprising a leather layer and a laminating layer. Hiroyoshi further teaches the leather layer is a rawhide and the laminating layer is a paper layer impregnated with a resin compounded with SBR synthetic latex. The paper layer is coated with an adhesive containing a thermosetting resin.

None of the reference teaches the laminating layer to be impregnated with a thermosetting resin. However, it has been held that making integral of separate parts a prima facie case of obviousness.

Moreover, Wilson teaches a leather board comprising a leather material impregnated with phenol formaldehyde. Therefore, it would have been obvious to one of ordinary skill in the art to have employed phenol formaldehyde as a thermosetting resin, as taught by Wilson, to impregnate the paper layer or laminating layer of Hiroyoshi or Schmidt-Troschke. This is because Wilson teaches that the use of a thermosetting resin such as phenol formaldehyde would enhance mechanical and tensile strength and wet-rub resistance.

Response to Arguments

10. Applicant's arguments with respect to the rejections of the claims in the prior Office action have been considered but are moot in view of the new ground(s) of rejection.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thao T. Tran/
Primary Examiner, Art Unit 1794